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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

FISH, JAMIESON W

ART UNIT PAPER NUMBER

2616

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,238

Applicant(s)

SATO, KEIJI

Examiner

Jamieson W. Fish

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ¹⁹18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/19/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 6-19-2001 has being considered by the examiner.

Specification

2. The abstract of the disclosure is objected to because Page 14 line 25 "MPE-G2" should be replaces with "MPEG-2." Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims **9-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP 2106.

Double Patenting

5. Applicant is advised that should claim **11** be found allowable, claim **12** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 6-7, 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikinis (US 5,929,849).

8. Regarding claim 1, Kikinis teaches a method of broadcasting programs, executed by a broadcasting unit in a broadcasting system, said broadcasting system also including at least one receiving unit of a listener, the method comprising the steps of: extracting an object that has been displayed onto the display screen of a program from the program information about programs (See Col. 8 lines 44-67 and Col. 9 lines 1-45); generating the relevant information about the extracted object (See Col. 8 lines 44-67 and Col. 9 lines 1-45); generating sync information to be used for synchronizing the program information with the relevant information (See Col. 8 lines 44-67 and Col. 9 lines 1-45 Tags are sync information); and transmitting the program information, relevant information, and sync information to said receiving unit (See Fig. 3A and Col. 9 lines 28-35).

9. Regarding claim 2, Kikinis teaches wherein the sync information includes the information about the time at which the object is displayed or the frames that contain the

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object, and the information about the display position at which the object is displayed (See Col. 8 lines 44-67 and Col. 9 lines 1-45).

10. Regarding claim 3, Kikinis teaches wherein the relevant information is the advertisement information about advertisement of the object (See Col. 8 lines 44-67 and Col. 9 lines 1-23)

11. Regarding claim 6, based of the specification (Page 38 lines 16-25) sponsor has been interpreted to mean an owner (i.e. "sponsor" of the receiver) and is not limited to one that pays the cost of a television program in exchange for advertising time. Thus, "recruiting a sponsor" for an extracted object is equivalent to having someone purchase an extracted object. Kikinis teaches a method of broadcasting programs, executed by a broadcasting unit in a broadcasting system, said broadcasting system also including at least one receiving unit of a listener, the method comprising the steps of: extracting an object displayed onto the display screen of a program from the program information about programs (See Col. 8 lines 44-67 and Col. 9 lines 1-23); generating the sponsor-recruiting information for recruiting a sponsor for the extracted object (See Col. 8 lines 44-67 and Col. 9 lines 1-23); and transmitting the program information and the sponsor-recruiting information to said receiving unit (See Col. 8 lines 44-67 and Col. 9 lines 1-23).

12. Regarding claim 7, Kikinis teaches a method of receiving programs, broadcast by a broadcasting unit, by a receiving unit of a listener, the method comprising the steps of: receiving the program information about a program to be broadcasted, relevant information about an object displayed onto the display screen of the program, and sync

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information for synchronizing the program information with the relevant information from said broadcasting unit (See Col. 8 lines 44-67 and Col. 9 lines 1-23); storing the received program information, relevant information, and sync information (See Col. 9 lines 28-35); and synchronously outputting the program information and relevant information in accordance with the stored sync information (See Col. 9 lines 24-67 Col. 10 lines 1-5).

13. Regarding claim **11**, claim **11** is a computer-readable recording medium which stores a computer program contains instructions which when executed realizes the method of claim **1**. Since Kikinis teaches where his system is implemented by computerized control circuitry (See Col. 3 lines 33-53), claim **11** is rejected according to claim **1**.

14. Regarding claim **12**, claim **12** is discussed and rejected according to claim **11**

15. Regarding claims **13**, **14** and **15**, claims **13**, **14**, and **15** are apparatus claims corresponding to the methods of claims **1**, **6**, and **7**, respectively. Thus claims **13**, **14**, and **15** are analyzed and rejected with respect to claims **1**, **6**, and **7**.

16. Claims **1**, **4-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 6,131,086).

17. Regarding claim **1**, Walker teaches a method of broadcasting programs, executed by a broadcasting unit in a broadcasting system, said broadcasting system also including at least one receiving unit of a listener, the method comprising the steps of: extracting an object that has been displayed onto the display screen of a program from the program information about programs (See Col. 9 lines 47-67); generating the

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relevant information about the extracted object (See Col. 7 lines 45-67 Text Overlay is relevant information); generating sync information to be used for synchronizing the program information with the relevant information (See Col. 7 lines 45-67 Since text overlay can be shown during the program, sync information is inherent); and transmitting the program information, relevant information, and sync information to said receiving unit (See Col. 7 lines 32-35).

18. Regarding claim 4, Walker teaches wherein the relevant information is the auction information about auction of the object, and the method further comprising the steps of: receiving purchase values of the object to be auctioned from said receiving unit (See Col. 4 lines 22-28, Col. 6 lines 57-67); and transmitting the highest value among the received purchase values (See Col. 4 lines 22-28, Col. 6 lines 57-67).

19. Regarding claim 5, Walker teaches the method further comprising the steps of: deciding the listener transmitting the highest price as a successful bidder of the object when broadcasting of the program information is completed (See Col. 4 lines 22-28, Col. 6 lines 57-67); and transmitting information about the successful bidder to the receiving unit (See Col. 4 lines 22-28, Col. 6 lines 57-67 The highest bidder would have to be notified).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims **8** and **16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis.

22. Regarding claim **8**, based of the specification (Page 38 lines 16-25) sponsor has been interpreted to mean an owner (i.e. "sponsor" of the receiver) and is not limited to one that pays the cost of a television program in exchange for advertising time. Thus, "recruiting a sponsor" for an extracted object is equivalent to having someone purchase an extracted object. Kikinis teaches a method of receiving programs, broadcast by a broadcasting unit, by a receiving unit of a listener, the method comprising the steps of: receiving the program information about a program to be broadcasted and sponsor-recruiting information for recruiting a sponsor for an object displayed onto the display screen of the program (See Col. 8 lines 44-67 and Col. 9 lines 1-23); storing the program information and sponsor-recruiting information (See Col. 8 lines 44-67 and Col. 9 lines 1-23 The sponsor recruiting information is the URL); outputting the stored program information and sponsor-recruiting information (See Col. 8 lines 44-67 and Col. 9 lines 1-23). Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit. Kikinis does disclose where his system is broad enough to implement common internet product purchasing functions (See Col. 8 lines 34-44 and Col. 11 lines 51-55). With the interpretation of sponsor used above, the limitation of transmitting sponsor-designating information is equivalent to transmitting a purchase confirmation to a user. The examiner takes Official Notice that transmitting a purchase confirmation to a user is

well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis so that a user was sent a purchase confirmation information after the user made a purchase to allow the user to verify the transaction.

23. Regarding claim 16, claim 16 is an apparatus claim corresponding to the methods of claim 8. Thus claim 16 is analyzed and rejected with respect to claim 8.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 4/20/2005


NGOC-YEN VU
PRIMARY EXAMINER